

DOCKET NO. TOS-157-USA-PCT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

T. Nakamura

)

Examiner: **J. Karol**

)

Serial No.: **10/501,462**

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Group Art Unit: **1617**

)

Filed: **December 13, 2004**

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Docket: **TOS-157-USA-PCT**

**For: Water-in-Oil Emulsion Composition And Emulsion Cosmetic
Comprising The Same**

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir: The undersigned hereby respectfully replies in the above-identified application to the Examiner's Answer mailed herein on November 12, 2008.

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I. STATUS OF THE CLAIMS

1. Rejected
2. Rejected
3. Cancelled
4. Rejected
5. Cancelled
6. Rejected
7. Cancelled

The claims on appeal are claims 1, 2, 4, and 6.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 1, 2, 4 and 6 are unpatentable under 35 U.S.C. 103(a) as being obvious over Delrieu, et al. in view of Sato, et al.

III. ARGUMENT

A. The Issues Presented In The Reply Brief

It is Appellant's position that the following issues discussed in appellant's brief and set forth below are controlling with respect to the issues concerning the final rejection in this case. These issues include:

1. Whether the Examiner applied an erroneous legal standard in interpreting base Claim 1 in the rejection.
2. Whether the PPG case cited by the Examiner stands for the proposition for which it is cited.
3. Whether the Examiner erred in concluding that the Specification or claims fail to set forth the basic and novel characteristics of the invention.
4. Whether the final rejection and/or the Examiner's Answer provides any justification for the failure of the Examiner in the final rejection to comply with the requirements of *KSR International Co. v. Teleflex, Inc., et al.*, 127 S.Ct. 1727 (2007) and *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).
5. Whether the Examiner's admissions in the Examiner's Answer provide a sufficient basis for overruling the Examiner's decision in the final rejection.

It is respectfully urged that the answer to the first, third, and fifth issue is in the affirmative, and that the answer to the second and fourth issues is in the negative. Each of these issues will be discussed separately below.

B. Arguments With Respect To Each Of The Above Issues

With regard to the first and second issues, appellants have urged that the Examiner applied an erroneous interpretation of the novel characteristics actually are, ‘consisting essentially of’ will be construed as equivalent to ‘comprising’”. See, e.g., PPG, 156 F. 3d at 1355, 48 USPQ 2d at 1355”.

Although the Examiner’s Answer again cites the PPG case and this proposition, there is no further discussion in the Examiner’s Answer concerning the Examiner’s interpretation of the PPG case and where this particular proposition can be found in the PPG opinion.

Appellant’s brief on appeal discusses this issue at length on pages 12-16 and also provides a copy of the decision for the convenience of the board. Despite the extensive discussion of this case in appellant’s brief, the Examiner’s Answer merely ignores appellant’s interpretation of the PPG case and fails to even refute in any way appellant’s contentions with regard to the proper interpretation of the PPG case.

Importantly, any refutation of appellant’s interpretation of the PPG case in the Examiner’s Answer is conspicuous in its absence. In this connection, the Examiner’s Answer fails to state where in the PPG case the proposition relied upon could be found either expressly or by implication. Of course, the Examiner’s reasons for ignoring this issue in the Examiner’s Answer is for the obvious reason that there is no discussion or holding in the PPG case to support the proposition in the PPG case which was relied upon by the Examiner.

Appellants therefore respectfully urge that the Examiner applied an erroneous legal standard in interpreting base Claim 1 in the final rejection, and the PPG case does not stand for the proposition for which it is cited.

B. With respect to the third issue, the Examiner's Answer points out on page 6 that appellant points out that the page 1, lines 7-16, of the "Specification sets forth the basic and novel characteristics of the invention (a water-in-oil emulsified composition that exhibits good, emulsified states, does not change over different temperatures and/or time, has superior stability, and gives a non-sticky, fresh, and good tactile sensation during use, as well as an emulsified cosmetic using this composition----"). The Examiner does not challenge that these basic and novel characteristics of the invention are in fact present in the specification. Therefore, even applying the Examiner's erroneous legal standard, one would have to conclude that there was no absence in the specification or claims of what the basic and novel characteristics of the invention. For this reason, it would follow, applying the Examiner's erroneous legal standard, that the term "consisting essentially of" should not be construed as equivalent to "comprising".

For these reasons, it is respectfully urged that the Examiner erred in concluding that the specification or claims failed to set forth the basic and novel characteristics of the invention.

C. With regard to the fourth issue, although appellant's brief discusses at length the requirements for compliance with the Supreme Court decisions in *KSR International Co. v. Teleflex, Inc., et al.*, supra, and *Graham v. John Deere, Co. of Kansas City*, supra, and the Examiner's failure to comply with the requirements of these cases, the Examiner's Answer fails to even mention these overriding and critical issues. Consequently, it must be concluded, absent any refutation, that the

Examiner's final rejection fails to comply with the requirements of either of these Supreme Court cases.

D. Respecting the fifth issue, the Examiner's Answer points out, in the paragraph bridging pages 7 and 8, that the product by process of Claim 1 requires the process steps of:

“(1) dissolving in water or an aqueous component a hydrophilic compound having gellation ability and consisting of one or more members of the group consisting of agar, carrageenan, curdlan, gelatin, gellan gum, and alginic acid;

(2) cooling said mixture below the gellation temperature to form a gel, then pulverizing said gel; and

(3) wherein said microgel is pulverized in a composition containing 65 -85 % of water phase parts which consist of water, aqueous component, and said microgel, ---“

The Examiner's Answer provides perhaps the clearest indication of what the prior art teaches and does not teach. For example, the Examiner's Answer on page 5, lines 9-11, states:

“However, Delrieu, et al. does not explicitly teach cosmetic compositions where the other ingredients are specifically disclosed or the specific percentages for the components.”

On page 8 of the Examiner's Answer, lines 9-12, the Examiner states:

“Second, while Delrieu, et al. does not cool the aqueous solution containing the agar below the gellation temperature to form a gel, which is then pulverized, the process steps taught by Delrieu, et al. result in materially the same microgel as claimed.”

On page 8, nine lines from the bottom, the Examiner further states that:

“Thus while the steps are not identical it is the position of the Examiner that the gel bead and pulverized gel microparticles are materially the same”.

And in the paragraph bridging pages 8 and 9 the Examiner admits that one of ordinary skill in the art would not crush the gel beads of Delrieu, et al. since crushing the beads would result in release of the active ingredients.

It is apparent from these admissions of the Examiner that the compositions of Delrieu, et al. differs in components and proportions to that called for in the present claims and that the step of cooling below the gellation temperature and then pulverizing would not be carried out on the Delrieu, et al. composition by one of ordinary skill in the art.


In view of these strange inconsistencies between the Examiner’s interpretation of the present claims under rejection and that of the prior art, it is respectfully urged that the Examiner’s conclusions regarding obviousness are inconsistent, illogical, and unwarranted as a matter of fact and law. Consequently, the Board would be justified in overturning the Examiner’s final rejection for the reasons set forth above.

C. Conclusion

Appellants respectfully urge that the Examiner’s Answer fails to address the legal issue in appellant’s brief or provide any refutation of appellant’s position on these legal issues. Moreover, the Examiner’s Answer contains numerous admissions which demonstrate that the Examiner’s final rejection is without foundation or merit, either factually or as a matter of law. Consequently, the Board would be fully justified in summarily overturning the Examiner’s final rejection.

Respectfully submitted,

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